

## **II. Under 37 C.F.R. §1.312, New Claim 21 Should Be Entered**

When adding a new claim pursuant to 37 C.F.R. §1.312, MPEP §714.16 requires the applicant to address the following: (A) why the amendment is needed; (B) why the proposed new claim requires no additional search or examination; (C) why the claim is patentable; and (D) why the claim was not presented earlier.

### **A New Claim Provides More Complete Coverage For the Allowed Subject Matter**

Applicant realized after filing an Amendment and Response on October 3, 1996 to the first Office Action mailed by the Examiner on June 5, 1996 that method claim 6 did not have a complimentary apparatus claim. Consequently, to properly cover both the method and apparatus of the present invention, Applicant believes that new claim 21 - an apparatus claim that compliments method claim 6 - is necessary.

### **B Proposed New Claim Does Not Require An Additional Search Or Examination**

New claim 21 does not require an additional search or examination because it claims computer software operative on a processor that performs the exact same steps as in allowed method claim 6. As in claim 6, except for the fact that claim 6 is a method claim and new claim 21 is an apparatus claim, both claims relate to "quantitatively evaluating image quality characteristics of an ultrasound scanner". Thus, the examiner has already searched this area and concluded that independent claims 1 and 6 and their dependent claims were allowable over the prior art.

Because the subject matter of claim 21 is the same as those previously presented, a new search is not necessary.

Furthermore, additional examination is not necessary for new claim 21 because it contains parallel language to method claim 6. The arguments for patentability of new claim 21 are the same as those presented in the Amendment and Response filed on October 3, 1996 arguing for the patentability of claim 6. Since the Examiner has examined method claim 6 and found it to be patentable, new claim 21 does not require additional examination.

**C. Claim 21 is Patentable**

Because new claim 21 contains language that is parallel to allowed method claim 6, claim 21 is patentable. Claim 21 claims an apparatus for quantitatively evaluating image quality of an ultrasound scanner. See Claim 6 ("A method of quantitatively evaluating image quality characteristics of an ultrasound scanner"). Then, both claims 6 and 21 claim the following three steps using parallel language: (1) "selecting a phantom test object within an image"; (2) "quantitative processing of said image to evaluate image quality characteristics of the scanner for diagnostic purposes"; and (3) "outputting results of the quantitative processing".

In addition to these steps, claim 21 claims a processor and computer software operative on the processor. Claim 21 specifies that the computer software is involved in performing the three steps claimed in allowed method claim 6. For these reasons, new claim 21 which is an apparatus claim the compliments allowed method claim 6 is patentable.

**D. New Claim Presented in a Supplemental Amendment Mailed One Day Before Notice of Allowance Mailed by Examiner**

In a Supplemental Amendment filed on October 29, 1996, Applicant attempted to present this new claim 21 to the Examiner prior to the issuance of the Notice of Allowance. On October 29, 1996, new claim 21 was mailed in a Supplemental Amendment by first class mail procedures to the Patent Office. See Attached Supplemental Amendment with the Certification that the Supplemental Amendment was mailed on October 29, 1996. The Examiner mailed the Notice of Allowance on October 30, 1996. However, even though in accordance with 37 C.F.R. 1.8 the Supplemental Amendment was filed with the Patent Office on October 29, 1996, the Examiner had mailed the Notice of Allowance before receiving the Supplemental Amendment. Thus, the Applicant tried to present new claim 21 prior to the issuance of the Notice of Allowance.

**CONCLUSION**

For the foregoing reasons, under 37 C.F.R. §1.312, Applicant respectfully requests the (1) entry of the minor amendment to allowed claim 6 and (2) the entry of new claim 21, which is a complimentary claim to allowed method claim 6.

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